

Remarks

This Response is in response to the Final Office Action dated January 12, 2007 in which the Examiner finally rejects all pending claims. Claims 1, 6 and 8-18 are currently pending and, for reasons stated below, the claims are allowable in view of the prior art of record.

Rejection under 35 U.S.C. §103(a)

Claims 1, 6 and 8-18 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Chan (Chan, N.T., Dahan, E., Lo, A.W. and Poggio, T. *Experimental Markets for Product Concepts*, Davis (U.S. Patent No. 6,269,361) and McAlpine (McAlpine, Rachel. *Web Word Wizardry*. Ten Speed Press. 2001. pp. 140-148). Applicants respectfully traverse and submit that the rejection is improper because (1) the Examiner has engaged in impermissible hindsight reconstruction in formulating the present rejection; and (2) the combination of Chan, Davis and McAlpine fail to teach or suggest all of the claimed elements claimed herein.

Improper Hindsight Reconstruction

It is well settled law that the Examiner cannot engage in impermissible hindsight reconstruction. The Examiner cannot use the Applicants' specification as a blueprint for the combination of prior art references. Applicants submit that in presenting the present rejection, the Examiner has engaged in improper hindsight reconstruction.

No motivation

It is noted that the present Office Action, as well as the previous non-final Office Action, both omit any stated motivation that one having ordinary skill in the art would have to combine these references. Applicants have previously asserted that Chan, Davis and McAlpine are all disparate and non-analogous references. Chan is directed to an electronic trading system, Davis is a system determining advertising costs on a search term and McAlpine is a “self-help” manual for how to get a web page recognized. One skilled in the art of electronic trading systems is different from one skilled in the art of online advertising payment / billing systems, which is different from one skilled in the art of getting web pages recognized by a search engine.

There is no motivation to combine these references outside of using the Applicants’ disclosure as a blueprint. Indeed, the Examiner has not provided a stated motivation for combining these reference beyond the conclusionary statement that “[i]t would have been obvious to one of ordinary skill at the time the invention was made to have ...” (page 5, lines 9-13). Applicants submit that outside of the context of the present application, there does not exist motivation to combine these references, thus constituting impermissible hindsight reconstruction.

Obviousness rejection

Review of the present rejection on the basis of obviousness further compels the conclusion that the rejection is improper. Chan is asserted for teaching a basic, and well known, electronic trading system. Indeed, Chan, as well as other electronic trading systems, is described in the background section of the present Application. Davis is asserted as teaching “old and well known” technology (page 4, line

16) and McAlpine is asserted as also teaching “old and well known” technology (page 5, line 1). Therefore, the obviousness rejection is based on the combination of a prior art system Applicants disclose and two “old and well known” technologies.

Applicants submit that with this being such an obvious form of combining “well known” technologies (as the Examiner has asserted), the rejection should be supported by an anticipatory reference. The fact that the best asserted position must combine three references of “well known” technology and an anticipatory reference has not been asserted clearly indicates that one having ordinary skill in the art has never sought to combine these technologies. In fact, as two of the three prior art references are non-patent publications, it would seem even more reasonable that if the present invention is such an obvious combination, an anticipatory non-patent reference could easily and readily be obtained. That is not presently the case.

Combination fails to teach or suggest all limitations

In the previous response, filed September 13, 2006, Applicants submitted the position that the combination of all three prior art references fails to teach or suggest all the claimed elements. In response to Applicants’ position that the prior art disclosure of “keywords” is inconsistent with recited element of “term based concepts,” the Examiner states, in total, “Applicant’s arguments filed 9/18/06 have been fully considered but they are not deemed persuasive.” Applicants note that the Examiner has not presented additional support contrary to Applicants previously-asserted position.

Applicants again submit that the combination of Chan, Davis and McAlpine fail to teach or suggest all of the claimed limitations. In support of the

rejection, the Examiner asserts Chan as an example of known electronic trading technology, McAlpine as an example of using and assigning a value to known search terms and Davis as an example of the utilization of “term-based concepts.” Applicants must respectfully disagree. Davis clearly and succinctly discusses a system for influencing search engine search results based on, *inter alia*, a search term “comprising one or more keywords” (Abstract, lines 10-11). And further review of Davis provides that the “search term 352 comprises one or more keywords which may be common words in English (or any other language). Each keyword in turn comprises a character string.” (col. 12, lines 45-48). Davis teaches bidding and pricing per term, which is wholly inconsistent with the claimed “term-based concepts.”

For further clarity, what Davis describes is a system where a pricing attaches to a term which may comprise multiple words, for example “personal computer.” By contrast, claim 1 recites, *inter alia*, “a set of terms for a term-based concept, each of the terms being usable in a computerized search to locate information.” At best, Davis discusses search terms, but interpreting the “search term” of Davis as teaching the “term-based concept” of the claimed invention is not only improper, but in direct contradiction to the explicit teachings of Davis. Chan, as being asserted for teaching a trading system, fails to overcome this deficiency.

McAlpine is also asserted as teaching the claimed “term-based concept,” to which Applicants respectfully disagree. Rather, McAlpine is not even analogous art as McAlpine discusses selecting terms for embedding in meta data of a web page. McAlpine discusses techniques for having meta data recognized by a search engine, including adding different types and variations of keywords (e.g. pink, peonies, Ontario,

order peonies ... on page 145). Embedding different keywords in metadata is inconsistent with the claimed “term-based concept” as claimed herein because the claimed terms are “usable in a computerized search to locate information,” and the grammatical variations of keywords in McAlpine are used for the information to be located. In other words, McAlpine is on the other end of the search perspective, being non-analogous art, and discusses variations of common terms which are inconsistent with a “term-based concept” as claimed herein.

Therefore, the combination of Chan, Davis and McAlpine, if combined, fails to teach or suggest all of the claimed elements recited herein.

Conclusion

Claims 1, 13 and 16-17 are independent claims and are allowable for at least the reasons stated above. As noted in the previous response filed September 13, 2006, claims 16 and 17 also recite additional patentable subject matter in addition to the elements discussed above. For the sake of brevity, Applicants resubmit those positions in addition to the above.

Additionally claims 6, 8-12, 14-15 and 18 depend from claims 1, 13 and 17, respectively, and are allowable for at least the same reasons stated above.

Therefore, Applicants respectfully request withdrawal of the present rejection and passage of claims to issuance. Should the Examiner maintain the present rejection, Applicants request withdrawal of the finality of the present rejection and the Examiner provide an asserted motivation to combine these references, such that Applicants may have a chance to properly understand the Examiner’s position and

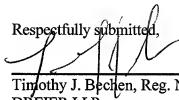
respond accordingly. In the event the rejection or the finality is not withdrawn, the present response is being submitted concurrently with a Notice of Appeal.

For at least all of the above reasons, Applicants respectfully request that the Examiner withdraw all rejections and objections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the examiner is invited to call the applicants' undersigned representative to discuss any issues relating to this application.

Dated: April 12, 2007

THIS CORRESPONDENCE IS BEING
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Respectfully submitted,



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